

REMARKS

Claims 1-35 are currently pending. Claims 1, 2, 4-7, 15, 19, 20, 22-24 and 29 have been amended. The amendment to claim 15 corrects a typographical error and is not intended to relate to patentability or to narrow the claim scope. Reconsideration is respectfully requested.

Rejections under 35 U.S.C. § 112, Second Paragraph

The Office Action includes a rejection of claims 7, 8, 11 and 29 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claim 7 has been amended to adjust its dependency from claim 1 to claim 5, thereby addressing the rejection of both claims 7 and 8. Claims 11 and 29 have been amended to set off the phrase "in the form of an animation" in commas, thereby addressing the rejection. The changes to claims 11 and 29 are not intended to narrow the claim scope. Withdrawal of the rejection is respectfully requested.

Art Rejections

The Office Action includes a rejection of claims 1-10, 12-28 and 30-35 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Daniels et al. patent (U.S. Patent No. 6,343,327). It is respectfully submitted that these claims are patentable over the Daniels et al. patent.

Independent claim 1 has been amended and recites a method for at least making ready for mailing a plurality of messages intended for a plurality of addressees. The method comprises selecting presentation instructions valid for said messages, for determining at least one form of presentation of said messages to

said addressees, and transferring a file of content-determining instructions determining the content of said messages and said presentation instructions to a peripheral device for at least making ready for mailing said messages. The method also comprises at least making ready for mailing said messages in accordance with said file of content-determining instructions and said presentation instructions.

Selecting said presentation instructions occurs by selecting a single, priorly stored file of presentation instructions, and said file of presentation instructions contains instructions concerning the design of the messages themselves and concerning the processing of the messages. Independent claim 19 has been amended and recites a data structure in computer-processable form for implementing various steps as recited therein, which include subject similar to that recited in claim 1.

In rejecting independent claims 1 and 19, the Office Action alleges (paragraphs 14 and 29) that the claimed presentation instructions correspond to the addressing information disclosed in the Daniels et al. patent and that the claimed content-determining instructions correspond to the control information disclosed in the Daniels et al. patent. The Office Action acknowledges (paragraph 14) that there is no disclosure in the Daniels et al. patent indicating that the addressing instructions include instructions concerning the design of the messages themselves. However, the Office Action suggests (paragraph 14) that it would have been obvious to alter the design of a message depending on the printstream (physical delivery or electronic delivery) to which the message was directed, because doing so would allow users to view the received message in a form optimized for the type of delivery (physical or electronic). The Office Action seems to suggest that the Daniels et al. addressing information would hypothetically contain instructions for altering message

design based on the type of delivery printstream, but does not explicitly make this indication.

It is respectfully submitted that the rejection, as best understood, does not make out a *prima facie* case of obviousness. First, even if, for the sake of argument, the design of documents in the Daniels et al. system were hypothetically altered depending upon the type of delivery (physical or electronic), the resulting modified system would still not possess the combination of features recited in independent claims 1 and 19.

As recited in claims 1 and 19, content-determining instructions are instructions that determine the content of the messages themselves. Presentation instructions are instructions for determining a form of presentation. As noted at page 1, lines 8-17 of the present application, examples of presentation instructions include instructions concerning the manner in which the message is sent, adding standard notices and images, and processing in a standard layout or not depending on whether the message is drafted in a flat or specially structured form. With regard to exemplary presentation instructions for e-mail, options include, for instance, sending as HTML or not, and using encryption or not. With regard to exemplary presentation instructions for facsimile, options include sending with or without a front page and the choice of the resolution (normal, fine or extra fine). With regard to exemplary presentation instructions for printed documents, options include the selection of the type of paper, the choice of any envelope, the choice of a mail class, the choice of inserts to be added, and the choice of the place where the physical document will be composed. Of course, the claimed subject matter is not limited to these examples.

According to claims 1 and 19, all the presentation instructions for a group of messages, which instructions contain instructions concerning the design of the message themselves, are selected by selecting a single, priorly stored file of presentation instructions. This permits, for example, generating a series of messages in accordance with the desired presentation instructions with a substantially reduced amount of instructions and, therefore, generating the messages in a quick and reliable manner. The prior assembly of sets of presentation instructions, which allow control over the communication medium used and visual appearance of the messages, for example, may thus be separated from actually using a set of presentation instructions to generate a series of messages to be sent.

In contrast, in the Daniels et al. system, generating messages involves the selection of templates and inserts from libraries 500, 502, 504, i.e. the selection of several files, which are combined into job setup files 402 and 518 (see Fig. 5 and column 6, lines 28-48). The job setup files, thus composed, contain sections each dedicated to a particular form of document transmission. In turn, each of these sections is composed of several files selected from the libraries. Delivery preferences, which indicate for each recipient how a document should be delivered, are selected from a customer database 202 (see Fig. 2 and col. 4, lines 46-48). The control information that indicates which inserts are to be included is taken from another source 204 (see Fig. 2, col. 4, lines 49-51). Thus, in the Daniels et al. system, the selection of presentation settings for a group of messages to be sent involves the selection of several instruction files from several sources, wherein the instructions are combined into conditional job-settings and delivery preferences,

which may vary from addressee to addressee. The purpose of this approach in the Daniels et al. system is to facilitate delivery of documents in various forms preferred by addressees.

Thus, it is evident that the Daniels et al. patent does not disclose selecting presentation instructions by selecting a single, priorly stored file of presentation instructions as recited in claim 1, nor does the Daniels et al. patent disclose presentation instructions that are selectable by selecting a single, priorly stored file of presentation instructions as recited in claim 19. The hypothetical modification suggested in the Office Action does not make up for this deficiency. Withdrawal of the rejection and allowance of claims 1 and 19 are respectfully requested for at least this reason.

In addition, it would not have been obvious to modify the Daniels et al. system to provide for selecting presentation instructions by selecting a single, priorly stored file of presentation instructions because the Daniels et al. patent teaches away from doing so. For the Daniels et al. system, the emphasis is on generating a job setting capable of selectively using several instruction files selected from several libraries in accordance with different delivery preferences within a single mailing, wherein the delivery preferences are received from a separate customer database, as discussed above. Thus, the disclosure in the Daniels et al. patent teaches away from combining the instructions regarding the processing of a document and the instructions regarding the design (in the sense of visual appearance) of the document itself, i.e. all the instructions regarding the presentation of the document, into a single file. Claims 1 and 19 are not obvious in view of the Daniels et al. patent for at least these additional reasons:

In addition, in the Daniels et al. system, the control information specifies what inserts are to be included with each document in the printstream. In contrast, according to claims 1 and 19, content-determining instructions are instructions that determine the content of the messages themselves. Accordingly, it is respectfully submitted that the Daniels control information does not properly correspond to the claimed content-determining information. Claims 1 and 19 are not obvious in view of the Daniels et al. patent for at least this additional reason.

For at least the above-noted reasons, it is respectfully submitted that independent claims 1 and 19 are not obvious in view of the Daniels et al. patent. Withdrawal of the rejection against claims 1 and 19 and allowance of the same are respectfully requested. Claims 2, 3, 6 and 9-18 depend variously from claim 1, and claims 20, 21 and 24-35 depend variously from claim 19. Accordingly, these claims are allowable at least by virtue of dependency.

Claims 4 and 22 have been placed in independent form and include revised language similar to that in claims 1 and 19. For example, claim 4 recites that selecting the presentation instructions occurs by selecting a single, priorly stored file of presentation instructions, wherein the file of processing instructions contains instructions concerning the design of the messages themselves and concerning the processing of the messages (and similarly for claim 22). As noted above, the Daniels et al. patent does not disclose or suggest this subject matter, and claims 4 and 22 are patentable over the Daniels et al. patent for at least this reason.

In addition, claims 4 and 22 recite that the selection of the presentation instructions is carried out by selecting a symbol displayed by a send dialog program. Thus the selection of the required presentation instructions for a group of messages

to be sent is made particularly simple, and is easily separated from the control over the possible combinations of presentation instructions in the files that can be selected. The Office Action (paragraph 16) suggests that it would have been obvious to modify the Daniels et al. system to represent files using a symbol because it is easier for a user to choose a symbol. However, this hypothetical modification does not make up for the deficiencies of the Daniels et al. patent described above. The Daniels et al. patent discloses that a dialog box prompts the user for templates, HTML files, text attachments, e.g. through a dialog box (column 6., lines 40-48). However, this dialog box relates to the creation of a job setup by selecting several files and not to the selection of a single file containing a combination of job setup instructions. Accordingly, claims 4 and 22 are further patentable over the Daniels et al. patent for at least this additional reason.

Claims 5 and 23 have been placed in independent form and include revised language similar to that in claims 1 and 19. For example, claim 5 recites that selecting the presentation instructions occurs by selecting a single, priorly stored file of presentation instructions, wherein the file of processing instructions contains instructions concerning the design of the messages themselves and concerning the processing of the messages (and similarly for claim 23). As noted above, the Daniels et al. patent does not disclose or suggest this subject matter, and claims 5 and 23 are patentable over the Daniels et a. patent for at least this reason.

In addition, claim 5 further recites that selecting the presentation instructions occurs under a particular user authorization and that editing the file of presentation instructions occurs, and is executable, exclusively under a different authorization than the user authorization (and similarly for claim 23). Thus, for example, this

allows the editing of the selectable files to be reserved to persons having the required authorization. The control over the presentation instructions is direct and protected. A request to realize production of a series of messages only needs to be accompanied by a request to use a particular set of presentation instructions, but a persons responsible for the actual production of the messages does not have access to edit the presentation instructions.

Contrary to the suggestion in the Office Action (paragraph 17), column 3, lines 43-55 and column 4, lines 26-33 of the Daniels et al. patent do not disclose this additional subject matter recited in claims 5 and 23. Neither of these sections contain any disclosure relating to selecting a file of presentation instructions by one user, and editing the file of presentation instructions exclusively by a different user. Rather, these sections of the Daniels et al. patent relate to dividing a printstream into physical delivery and electronic delivery, and to regeneration of an undeliverable message in a different form (using another communication medium), respectively. This regeneration of a message in a different form is carried out automatically and requires no user intervention at all. With respect to this feature disclosed in the Daniels et al. patent, the user's authorization profile is irrelevant for the regeneration of messages that suffered failed deliveries. Claims 5 and 23 are further patentable over the Daniels et al. patent for at least these additional reasons. Claims 7 and 8 depend from claim 5 and are therefore allowable at least by virtue of dependency.

The Office Action also includes a rejection of claims 11 and 29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Daniels et al. patent in view of the McCauley et al. patent (U.S. Patent No. 6,434,578). Claims 11 and 29 depend from claims 1 and 19, respectively. The Office's reliance on the McCauley et al.

patent for allegedly disclosing animation as recited in claims 11 and 29 does not make up for the deficiencies of the Daniels et al. patent discussed above in connection with claims 1 and 19. Accordingly, it is respectfully submitted that claims 11 and 29 are patentable over the applied references at least by virtue of dependency.

Conclusion

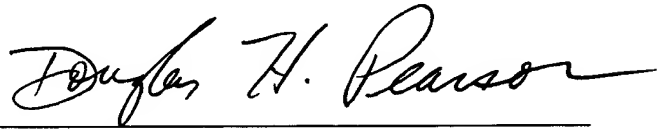
In light of the foregoing, withdrawal of the rejections of record and allowance of this application are respectfully requested. Should there be any questions in connection with this application, the Office is invited to contact the undersigned at the number below.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 8, 2004

By: _____



Douglas H. Pearson
Registration No. 47,851

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620